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10/712,442

11/13/2003

James Phifer

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07/19/2006

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EXAMINER

BANGACHON, WILLIAM L

ART UNIT

PAPER NUMBER

2612

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,442

Applicant(s)

PHIFER, JAMES

Examiner

William L. Bangachon

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-18 and 20 is/are rejected.
- 7) ☒ Claim(s) 5, 14, 15 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5/15/2006 have been fully considered but they are not persuasive.

The Examiner respectfully traverse applicant's argument that **"Welch does not disclose a cylindrical control stick shaped as an aviation stick which allows the grasping of the control stick and the simultaneous manipulation of the control switches"** [Remarks, page 10, lines 11-15; page 11, lines 5-8]. The claims do not state that the digits of the same hand manipulate the control switches. As shown in Figures 1 and 2 in Welch, the remote control includes a handle 20 that is clearly cylindrical in shape, and emulates an aviation stick. This allows the user to operate the control switches 60 to control a television or other system while holding the aviation stick 20 without having to pause to set down his or her drink {Welch, col. 3, lines 54-57}.

The Examiner respectfully traverse applicant's argument that **"Samulewicz does not disclose a cylindrical control stick shaped as an aviation stick which allows the grasping of the control stick and the simultaneous manipulation of the control switches"** [Remarks, page 11, lines 5-8, last paragraph; page 13, last paragraph]. The claims do not state that the digits of the same hand manipulate the control switches. The remote controller of Samulewicz includes a handle 13 that emulates an aviation stick as shown in Figure 1, devised to permit ease of use by persons who are manually

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impaired, or who have eyesight deficiency {Samulewicz, col. 1, lines 50-55+}. As shown in Figure 1, the shape of the handle 13 resembles a cylinder with uneven surface.

The Examiner respectfully traverses applicant's argument that **"Totsuka et al does not disclose a cylindrical control stick shaped as an aviation stick which allows the grasping of the control stick and the simultaneous manipulation of the control switches"** [Remarks, page 12, 3rd paragraph; page 13, last paragraph]. The claims (1 and 13) do not state that the digits of the same hand manipulate the control switches. Therefore, as shown in Figure 1 of Totsuka et al, the shape of the handle 13 resembles a cylinder with uneven surface. The self-standing mini-remote commander 10 of Totsuka as shown in Figures 1-3 shows that the corners are rounded and resembles a cylindrical shape and a hand-sized aviation stick that stands in an upright position {Totsuka, col. 1, lines 50-56}.

Finally, applicant's arguments with respect to claims 16-18 and 20 have been considered but are moot in view of the new ground(s) of rejection. Accordingly, the rejection of claims 1-14, 16-18 and 20, is maintained in this Office action.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character **"28"** has been used to designate **'grip', 'control stick base' and 'control stick'**.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the a) **"electrical**

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circuit and electrical circuit comprising a memory” recited in claims 1, 8, 1, 8, 10-11, 13, 14-16, 18 and 20; b) **“plurality of control switches including a plurality of VCR control switches mounted on said control stick positioned to be manipulated by the digits of the hand while holding the control stick in the palm of the hand”** recited in claim 13 (i.e. Figure 6 shows the plurality of television control switches but not the plurality of VCR control switches); and c) **“plurality of control switches including a plurality of DVD control switches mounted on said control stick positioned to be manipulated by the digits of the hand while holding the control stick in the palm of the hand”** recited in claim 18 (i.e. Figure 6 shows the plurality of television control switches but not the plurality of DVD control switches), must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New

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Sheet” pursuant to 37 CFR 1.121(d). If the Examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 1, 13 and 18 having been amended, the objection to the claims in the previous Office action is withdrawn.

4. Claim 5 is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(a). Correction of the following is required: **“The television control functions”** lacks antecedent basis in the claims.

5. Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 14 recites **“a first keypad”**. It is unclear whether said first keypad is the same keypad recited in claim 10. It is unclear whether it is a redundant keypad or an alternative placement of the first keypad. **It appears that claim 14 should depend from claim 13, not claim 12.** For the purpose of this Office action, claim 14 will be treated as if it depends on claim 13.

Claim Rejections - 35 USC § 112

6. The rejection of claims 13, 15 and 18 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1, 2, 7 and 13, are rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,701,123 (Samulewicz).

In claims 1 and 2, Samulewicz teaches of an ergonomic remote control device for the remote control of a television set, the remote control device comprising:

a cylindrical housing 13 substantially in the shape of aviation control stick (i.e. pistol grip type construction) shown in Figure 1, adapted for being held by a human hand and being manipulated by the digits of the hand, fixed to a base (11) such that the housing will stand upright, making it less likely to get lost {paragraph bridging cols. 1 and 2}.

a plurality of control switches (21, 23, 25) mounted on said control stick positioned to be manipulated by the digits of the hand,

an infrared transmitting light diode housed in said control stick for transmitting television viewing control signals to a television set {col. 3, lines 54-57},

an electrical circuit contained within said housing capable of encoding signals from said plurality of control switches for transmission through said infrared light diode {col. 3, lines 48+}, and

a battery power supply (31) mounted within said housing for supplying power for said electrical circuitry {col. 4, lines 17-18}.

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In claim 7, said plurality of switches further comprises at least one readily available finger trigger switch (15) mounted on the back upper portion of the control stick.

Claim 13 recites the limitation of claim 1 further comprising a plurality of VCR control switches (25) by pressing VCR switch 21 and a plurality of television control switches (25) by pressing TV switch 21.

11. Claims 9-10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,701,123 (Samulewicz).

In claim 9, although Samulewicz does not disclose, "said power supply source comprises at least one battery mounted within said base", the placement of the battery is just a matter of obvious design choice and would have been obvious in the system of Samulewicz to one of ordinary skill in the art, at the time of applicant's invention, because it does not change the functionality of the remote control of Samulewicz.

In claims 10 and 14, Samulewicz do not disclose expressly a "first keypad mounted in a recess on a first lateral side of said base". However, these claim limitations are an obvious design choice and would have been obvious in the system of Samulewicz, because moving the keypad to the lateral side of the base do not change the functionality of the remote control.

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12. Claims 3-6, 8, 11-12 and 16-17, are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,701,123 (Samulewicz) in view of USP 5,457,448 (Totsuka et al).

In claims 3, 4, 6, 12 and 17, Samulewicz does not disclose a "thumb switch having a four or five position switch". Totsuka, in the same field of endeavor, teach of a remote control housing substantially in the shape of a control stick, adapted for being held by a human hand and being manipulated by the digits of the hand, fixed to a base (50) such that the housing will stand upright as shown in figures 1, 3, 5 {col. 2, lines 53+; col. 3, lines 43-50} comprising a "thumb switch (12, 14) having a four position switch". Totsuka teaches that the thumb switch is advantageous because it can be used to group television channel and volume up/down control {Totsuka, col. 3, lines 37-40}. It would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to include the thumb switch of Totsuka having a four or five position switch in the system of Samulewicz because, as taught by Totsuka, the thumb switch can be used the control the television channel and volume.

In claims 8, 11, 16, Samulewicz teaches said trigger switch to signal a change in channel {Samulewicz, col. 4, lines 30-35} but do not disclose **"said electrical circuit is further adapted with a memory for retaining a plurality of user programmable television channels"**. Totsuka et al, in the same field of endeavor, teach of a user programmable television remote control unit comprising an erasable programmable read-only memory (36) (i.e. memory for retaining a plurality of user programmable television channels) {Totsuka, col. 3, lines 24+}. Totsuka suggests that an erasable

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programmable read-only memory (36) is beneficial because the control functions of the remote control unit can be changed so as to control various other kinds of electronic equipment {Totsuka, col. 3, lines 27-31}. Therefore, at the time of applicant's invention, it would have been obvious to one of ordinary skill in the art to include the erasable programmable read-only memory of Totsuka in the system of Samulewicz because, as taught by Totsuka, the control functions of the remote control unit can be changed so as to control various other kinds of electronic equipment.

13. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,701,123 (Samulewicz) in view of USP 6,549,143 (O'Donnell et al).

Claim 18 recites the limitations of claim 1. Samulewicz does not disclose a plurality of DVD control switches. O'Donnell, in the same field of endeavor, teach of a universal remote controller for controlling both a television and DVD in a single remote control unit {O'Donnell, col. 3, lines 3-10+}. O'Donnell teaches that controlling both a television and DVD in a single remote control unit is advantageous because of the lower cost of implementation as compared to having separate remote controllers for a television set and DVD {O'Donnell, col. 1, lines 13-17; col. 2, lines 35-41}. Therefore, at the time of applicant's invention, it would have been obvious to one of ordinary skill in the art to include the control of a DVD in the remote control unit of Samulewicz because, as taught by O'Donnell, it lowers the cost of implementation as compared to having separate remote controllers for a television set and DVD.

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14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,701,123 (Samulewicz) in view of USP 6,549,143 (O'Donnell et al), and further in view of USP 5,457,448 (Totsuka et al).

Claim 20 recites the limitations of claim 11 and therefore rejected for the same reasons.

15. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 6,483,440 (Welch).

In claim 1, Welch teaches of an ergonomic remote control device for the remote control of a television set, the remote control device comprising:

a handle and base 20 (i.e. cylindrical housing substantially in the shape of a aviation control stick) {col. 3, lines 16-20+}, adapted for being held by a human hand and being manipulated by the digits of the hand, fixed to a base plate (70) such that the housing 20 will stand upright as shown in figures 1 and 2 {col. 3, lines 52-57+},

a plurality of control switches (60) mounted on said control stick 10 positioned to be manipulated by the digits of the hand while holding the cylindrical housing in the palm of the hand {col. 3, lines 54-57},

an infrared transmitting light diode (80) housed in said control stick for transmitting television viewing control signals to a television set {paragraph bridging cols. 3 and 4},

an electrical circuit contained within said housing capable of encoding signals from said plurality of control switches for transmission through said infrared light diode {col. 3, lines 39-42}, and

a power supply mounted within said housing for supplying power for said electrical circuitry {col. 3, lines 36-40}.

16. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,483,440 (Welch).

In claim 9, although Welch does not disclose, "said power supply source comprises at least one battery mounted within said base", the placement of the battery is just a matter of obvious design choice and would have been obvious in the system of Welch to one of ordinary skill in the art, at the time of applicant's invention, because it does not change the functionality of the remote control of Welch.

17. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,483,440 (Welch) in view of USP 6,549,143 (O'Donnell et al).

Claim 13 recites the limitations of claim 1. Although Welch suggest the need to control other appliances while holding the handle 20 {Welch, col. 3, lines 54-56}, Welch does not disclose controlling a television set and a VCR. O'Donnell, in the same field of endeavor, teach of a universal remote controller for controlling both a television set and VCR in a single remote control unit {O'Donnell, col. 3, lines 3-10, lines 14-21+}. O'Donnell teaches that controlling both a television and VCR in a single remote control

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unit is advantageous because of the lower cost of implementation as compared to having separate remote controllers for a television and VCR {O'Donnell, col. 2, lines 35-41}. Therefore, at the time of applicant's invention, it would have been obvious to one of ordinary skill in the art to include the control of a television and VCR in the remote control unit of Welch because, as taught by O'Donnell, it lowers the cost of implementation as compared to having separate remote controllers for a television and VCR.

18. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,483,440 (Welch) in view of USP 6,549,143 (O'Donnell et al).

Claim 18 recites the limitations of claim 1. Although Welch suggest the need to control other appliances while holding the handle 20 {Welch, col. 3, lines 54-56}, Welch does not disclose controlling a television set and a DVD. O'Donnell, in the same field of endeavor, teach of a universal remote controller for controlling both a television and DVD in a single remote control unit {O'Donnell, col. 3, lines 3-10+}. O'Donnell teaches that controlling both a television and DVD in a single remote control unit is advantageous because of the lower cost of implementation as compared to having separate remote controllers for a television set and DVD {O'Donnell, col. 1, lines 13-17; col. 2, lines 35-41}. Therefore, at the time of applicant's invention, it would have been obvious to one of ordinary skill in the art to include the control of a television and VCR in the remote control unit of Welch because, as taught by O'Donnell, it lowers the cost of

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implementation as compared to having separate remote controllers for a television set and DVD.

Allowable Subject Matter

19. Claims 15 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

20. The following is a statement of reasons for the indication of allowable subject matter: With regards to claims 15 and 19, the prior art made of record does not disclose "a second keypad having a plurality of VCR control buttons mounted in a recess on a second lateral side of said base", in combination with a first keypad having a plurality of television control buttons mounted in a recess on a first lateral side of said base and plurality of switches comprising a digit keypad mounted on the upper portion of the control stick.

21. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Examiner Contact Information

22. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to William Bangachon whose telephone number is (571)-

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272-3065. The Examiner can normally be reached on Monday – Thursday, 8:30 AM – 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Wendy Garber can be reached on **(571)-272-7308**. The fax phone numbers for the organization where this application or proceeding is assigned is **571-273-8300** for regular and After Final formal communications. The Examiner's fax number is **(571)-273-3065** for informal communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



William L. Bangachon
Examiner
Art Unit 2635



BRIAN ZIMMERMAN
PRIMARY EXAMINER

July 14, 2006